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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/983,031	10/22/2001	Peter Alleine Fletcher	169.2196	8202

5514 7590 05/27/2005

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NEW YORK, NY 10112

EXAMINER

JOHNS, ANDREW W

ART UNIT	PAPER NUMBER
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2621

DATE MAILED: 05/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/983,031

Applicant(s)

FLETCHER ET AL.

Examiner

Andrew W. Johns

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2004 and 11 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-140 is/are pending in the application.
- 4a) Of the above claim(s) 43-58,99-113,130-132 and 137-140 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-42,59-98,114-117 and 119-129 is/are allowed.
- 6) ☒ Claim(s) 118 and 133-136 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/18/02, 12/18/03, 2/8/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Species A (corresponding to claims 1-42, 59-98, 114-129 and 133-136) in the reply filed on 29 December 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (M.P.E.P. § 818.03(a)).

2. Claims 43-58, 99-113, 130-132 and 137-140 are withdrawn from further consideration pursuant to 37 C.F.R. § 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 29 December 2004.

Drawings

3. The drawings are objected to because the top margin for Figures 3A, 3B, 10A, 11A and 13 is not at least one inch (2.5 cm) and the left margin for Figure 7B is not at least one inch (2.5 cm), as required by 37 C.F.R. § 1.84(g). Corrected drawing sheets in compliance with 37 C.F.R. § 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either

“Replacement Sheet” or “New Sheet” pursuant to 37 C.F.R. § 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claims

5 4. Claim 77 includes an apparent typographical error. It is believed that the recitation of “fanned” at line 2 should read --formed--. Applicant is encouraged to review the claims for any additional typographical errors.

Claim Rejections - 35 U.S.C. § 112

5 5. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

10 The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 118 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as
15 the invention.

 The recitations in lines 2 and 3 seems incomplete. Specifically, line 2 reads “function is of the form.” while line 3 begins “wherein said basis function...” The claim does not appear to ever define the form of the function, so that it is unclear what the function is and the claim fails to clearly point out and define the invention. Further, the recitation beginning at line 3 is
20 substantially identical to the language of claim 117, and is redundant therewith.

Claim Rejections - 35 U.S.C. § 101

7. 35 U.S.C. § 101 reads as follows:

25 Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 133-136 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Claims 133-136 are drawn to non-functional descriptive material. M.P.E.P. § 2106.IV.B.1(a) (Nonfunctional Descriptive Material) states:

5 Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. § 101.

10 Where certain types of descriptive material, such as music, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing process performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer.

15 For example, music is commonly sold to consumers in the form of a compact disc. In such cases, the known compact disc acts as nothing more than a carrier for nonfunctional descriptive material. The purely nonfunctional descriptive material cannot alone provide the practical application for the manufacture.

20 M.P.E.P. § 2106.IV.B.I (Nonstatutory Subject Matter) states:

When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement.

Claims 133-136 currently recite a watermarked image. There is no functional relationship
25 imparted by this data to a computing device. Specifically, while the image has a watermark pattern embedded therein, this pattern (either alone or in combination with the image it is embedded into) does not constitute functional descriptive material that, in and of itself, imparts specific functionality upon a general purpose computer. Therefore, claims 133-136 are directed towards non-functional descriptive material, which is non-statutory per se.

30 ***Allowable Subject Matter***

9. Claims 1-42, 59-98, 114-117, and 119-129 allowed.

10. Claim 118 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. § 112, 2nd paragraph, set forth in this Office action.

11. The following is a statement of reasons for the indication of allowable subject matter:
None of the prior art teaches or suggests the use of basis functions defined such that the basis
function when correlated with a scaled and rotated version of the basis function is substantially
equal to the auto-correlation of the function within a complex multiplicative constant, as
5 variously required by claims 1, 14, 18, 22, 31, 36, 59, 72, 76, 80, 87, 92, 114, 120, 127, and 128.
In addition, the prior art also fails to teach or suggest the specific basis function defined in claims
13 and 71. Therefore, each of these claims is allowable over the prior art.

Conclusion

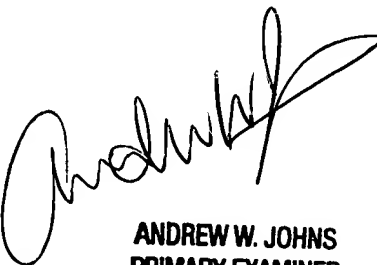
12. The prior art made of record and not relied upon is considered pertinent to applicant's
10 disclosure. The cited references each variously teaches either watermarking that is resistant to
rotation and scaling, or the use of autocorrelation to define a watermark pattern.

13. Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Andrew Johns whose telephone number is (571) 272-7391. The
examiner is normally available Monday through Friday, at least during the hours of 9:00 am to
15 3:00 pm Eastern Time. The examiner may also be contacted by e-mail using the address:
andrew.johns@uspto.gov. (Applicant is reminded of the Office policy regarding e-mail
communications. See M.P.E.P. § 502.03)

20 If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Bhavesh
Mehta, can be reached at (571) 272-7453. The fax phone number for this art unit is (703) 872-
9306. In order to ensure prompt delivery to the examiner, all unofficial communications should
be clearly labeled as "Draft" or "Unofficial."

25 Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the Technology Center Receptionist whose telephone number is (571) 272-
2600.

30
A. Johns
20 May 2005


ANDREW W. JOHNS
PRIMARY EXAMINER